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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/668,049	09/22/2003	Julie Theel	10639/1	7272

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STEPTOE & JOHNSON LLP
1330 CONNECTICUT AVENUE, NW
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EXAMINER

HYLINSKI, ALYSSA MARIE

ART UNIT	PAPER NUMBER
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3711

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	02/20/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/668,049

Applicant(s)

THEEL, JULIE

Examiner

Alyssa M. Hylinski

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.138(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 November 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 21-30 and 41-47 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 21-30 and 41-47 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 November 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Priority

1. Applicant's claim for the benefit of a prior-filed application under 35 U.S.C. 119(e) or under 35 U.S.C. 120, 121, or 365(c) is acknowledged. However, Applicant incorrectly disclosed the filing date of the prior application No. 10/154,217, as September 23, 2003 as opposed to May 20, 2002 in the first line of the specification. Appropriate correction is required.

Drawings

2. The drawings were received on 11/29/06. These drawings are acceptable.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 21-24, 28-29, 41-44 and 46-47 rejected under 35 U.S.C. 102(b) as being anticipated by VanNatter (5553570). VanNatter discloses a pet toy device for a house pet such as a dog having a main member (32, 34) with an exterior surface and an interface surface (Fig. 2) wherein the main member exterior surface can be non-destructively gripped by a house pet using its mouth and paws. The main member interface surface includes a first portion of a snap connector (Fig. 2). The toy further includes a secondary member (32,34) with an exterior surface that can be non-destructively gripped by a house pet using its mouth and paws (Fig. 2). The secondary

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member has an interface surface that includes a second portion of a snap connector that mates with a corresponding first portion of the snap connector on the main member interface surface (Fig. 2). The main and secondary members are shaped and sized to prevent swallowing by a house pet (Fig. 2). The interface surfaces of the main member and the interface surfaces of the secondary members are attachable by a human to create an attached toy state via the snap connectors which could be non-destructively detached by a house pet using its mouth and paws to create a detached toy state by disconnecting the snap connectors which could then be reattached by a human after being separated (column 2 line 36). The exterior surfaces main and secondary members would be sufficiently durable to withstand biting and chewing by a house pet since it is intended to be used as a pet toy. The interface surfaces of the main member and the secondary members are attached securely enough via the snap connectors to require an amount of force to detach the secondary member from the main member (column 4 lines 19-25). The first portion of a snap connector includes a protrusion (38) and the second portion of a snap connector includes a mating socket portion (36), where the first portion of the snap connector is shaped and sized to snap into the second portion of the snap connector attaching the main member to the secondary member (Fig. 2). The first portion of a snap connector includes a socket portion (36) and the second portion of a snap connector includes a mating protrusion (38), where the first portion of the snap connector is shaped and sized to snap onto the second portion of the snap connector attaching the main member to the secondary member (Fig. 2).

5. Claims 21 and 26 are rejected under 35 U.S.C. 102(b) as being anticipated by Russell (5195917). Russell discloses a toy that could be used by a house pet having a main member (12) with an exterior surface and an interface surface (Fig. 2) wherein the main member exterior surface could be non-destructively gripped by a house pet using its mouth and paws. The main member interface surface includes a first portion of a hook and loop fastener (column 1 lines 27-37). The toy further includes secondary members (Fig. 2) with exterior surfaces that could be non-destructively gripped by a house pet using its mouth and paws. The secondary member has an interface surface that includes a second portion of a hook and loop connector that mates with a corresponding first portion of the snap connector on the main member interface surface (Fig. 1). The main and secondary members are shaped and sized to prevent swallowing by a house pet (Fig. 2). The interface surfaces of the main member and the interface surfaces of the secondary members are attachable by a human to create an attached toy state via the snap connectors which could then be detached by a house pet using its mouth and paws to create a detached toy state by disconnecting the elements which could then be reattached by a human after being separated (Figs. 1 & 2).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 25 and 45 rejected under 35 U.S.C. 103(a) as being unpatentable over VanNatter. The device of VanNatter discloses the basic inventive concept, substantially as claimed with the exception of the device being made of denim, plush, corduroy or rubber. The examiner notes that mere selection of known materials as recited in claims 25 and 45, on the basis of suitability for the intended use would be entirely obvious.

See in re Leshin, 125 USPQ 416 (CCPA 1960). Therefore, it would have been obvious to one of ordinary skill in the art to provide VanNatter with the materials recited in the claims in order to use known materials suitable for the intended use.

8. Claim 27 is rejected under 35 U.S.C. 103(a) as being unpatentable over Russell and Alonso (3375604). Russell discloses the basic inventive concept substantially as claimed with the exception of the main and secondary members being attached using magnets. Alonso discloses a figure toy having separable parts held together with magnetic means (abstract). It would have been obvious to one of ordinary skill in the art from the teaching of Alonso to have the parts connected with magnets since it would provide an easy and simple means of connecting and disconnecting a toy figure.

9. Claim 30 is rejected under 35 U.S.C. 103(a) as being unpatentable over VanNatter and Snook (6601539). VanNatter discloses the basic inventive concept with the exception of a cord connecting the members. Snook discloses a dog toy that has separate elements (100, 200) connected by a cord (Fig. 2). It would have been obvious to one of ordinary skill in the art from the teaching of Snook to include a cord attaching the members together in order to increase the value of the toy since it could also be used as a pull toy (Fig. 3).

Response to Arguments

10. Applicant's arguments filed 11/29/06 have been fully considered but they are not persuasive. In response to applicant's argument that the toy of VanNatter does not disclose a pet toy, wherein the interface surfaces of the main member and the interface surfaces of the secondary members are attachable by a human to create an attached toy state, non-destructively detachable by a house pet using its mouth and paws to create a detached toy state, and repeatably reattachable by a human to recreate an attached toy state after being detached by a house pet thereby enabling a house pet to tear apart the main and secondary members of the toy by gripping the exterior surfaces of the toy with its paws and mouth, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. Although the screw threaded attachment mechanism for one embodiment of the invention does require a person to unscrew the two halves of the toy device other embodiments such as the friction fit attachment (Fig.2) is capable of being separated by the animal and can therefore satisfy the intended use as disclosed by applicant. In response to applicant's argument that since the toy of VanNatter discloses components that can be swallowed by a house pet the reference teaches away from the claimed invention, however a main member and a secondary member having an interface surface that corresponds with an interface surface of the main member that are intended to be gripped by the house pet are sized to prevent swallowing and therefore

meet the claim. In response to applicant's argument that "references cannot be combined where reference teaches away from their combination", the examiner notes that no references were combined in the above rejection of claims 21-24, 28-29, 41-44 and 46-47.

11. In response to applicant's argument that the toy of Russell does not disclose the members of the toy being sized and shaped so as to prevent swallowing by a house pet, the reference does not disclose the exact dimensions of the toy so the toy is capable of being sized and shaped so as to prevent swallowing by a house pet depending on the size of the pet. Furthermore, it has been held that a mere change in the size of a component is generally recognized as being within the level of ordinary skill in the art. In re Rose, 220 F.2d 459, 105 USPQ 237 (CCPA 1955).

Conclusion

12. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alyssa M. Hylinski whose telephone number is 571-272-2684. The examiner can normally be reached on M-F (8-5:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eugene Kim can be reached on 571-272-4463. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

AMH


EUGENE KIM
SUPERVISORY PATENT EXAMINER